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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,077	02/05/2001	Dimitri Kanevsky	YOR920000475US1(13823)	9551

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Richard L. Catania
Scully, Scott, Murphy & Presser
400 Garden City Plaza
Garden City, NY 11530

EXAMINER

GART, MATTHEW S

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 10/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/777,077

Applicant(s)

KANEVSKY ET AL.

Examiner

Matthew s Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

This application has been filed with informal drawings, which are acceptable for examination purposes only. The figures contain improper lines and text, which may affect clarity when reproduced.

Applicant is required to submit a formal correction of the noted defect. Applicant is required to submit drawing corrections promptly. Drawing objections may no longer be held in abeyance.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-21 are rejected under 35 U.S.C. 101. The claimed invention is directed to non-statutory subject matter.

Referring to claims 1-21. Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature that constitute "descriptive material."

Nonfunctional descriptive material" includes but is not limited to music, literary works and in this case a mere application of data. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance. In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978).

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Thus, the application in the instant invention is not a computer component and it does not become statutory by merely running it on a CPU. A patent cannot be granted on Computer Programs not claimed as embodied in computer-readable media. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760

In conclusion, since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 and 20-21 are rejected under 35 U.S.C. 112 second paragraph.

Referring to claims 1-13. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. In re Swinehart, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). The functional limitations in the instant applications are not associated with any

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elements, ingredients, or steps of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. Furthermore, the claims are generally narrative and indefinite, failing to conform to current U.S. practice.

Referring to claims 20-21. Claims 20-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. In re Swinehart, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). The functional limitations in the instant applications are not associated with any elements, ingredients, or steps of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. Furthermore, the claims are generally narrative and indefinite, failing to conform to current U.S. practice.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or
- (2) a patent granted on an application for patent by another filed in the United States before

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the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated
by Allen U.S. Patent No. 6,041,316.**

Referring to claim 1. Allen discloses an application system that is running in CPU and that is capable to changing of the appearance and performance of specified applications in such a way to force a user to abandon this specified application and purchase a new one (column 7, line 10 to column 8, line 57).

Referring to claim 2. Allen further discloses a system where changing of the appearance includes change color (column 8, lines 22-25).

Referring to claim 3. Allen further discloses a system wherein changing of the performance includes features that gradually drop out (column 7, lines 47-65).

Referring to claim 4. Allen further discloses a system where changing in the program appearance leads to degradation of the view of the application (column 8, lines 18-26).

Referring to claim 5. Allen further discloses a system where changes in performance lead to degradation of performance (column 7, line 10 to column 8, line 57).

Referring to claim 6. Allen further discloses a system where colors, contrast and fonts are degraded (column 8, lines 22-25).

Referring to claim 7. Allen further discloses a system where changes are adjusted to time and starts after some time limits (column 8, lines 43-57).

Referring to claim 8. Allen further discloses a system where adjustment to time means gradual changes (column 8, lines 43-57).

Referring to claim 9. Allen further discloses a system where the system is part of the specified application (column 7, line 10 to column 8, line 57).

Referring to claim 10. Allen further discloses a system where changes are obtained by manipulating drives in PC (column 7, line 10 to column 8, line 57).

Referring to claim 11. Allen further discloses a system where users pay money or view advertisements to reduce or eliminate degradation (abstract).

Referring to claim 12. Allen further discloses a system where money is paid to any of: software manufacturer, seller, third party, or degradation service provider (abstract).

Referring to claim 13. Allen further discloses a system where the amount of degradation is related to the amount of money paid (abstract).

Referring to claims 14-16. Claims 14-16 are rejected under the same rationale as set forth above in claims 1-13.

Referring to claims 17-19. Claims 14-16 are rejected under the same rationale as set forth above in claims 1-13.

Referring to claims 20-21. Claims 14-16 are rejected under the same rationale as set forth above in claims 1-13.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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"What the customer can do about software disabling devices," Stephen M Goldberg. Practical Lawyer. Philadelphia, April 1999, Vol. 45, Iss. 3, pg. 71


Any inquiry concerning this communication should be directed to Matthew Gart whose telephone number is 703-305-5355. This examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MSG

September 24, 2003



Jeffrey A. Smith
Primary Examiner